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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,269	12/09/2003	Randy W. Westlund	06809.0020-04000	3325
22852	7590	07/12/2005		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER LAYNO, CARL HERNANDZ	
			ART UNIT 3762	PAPER NUMBER

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/730,269

Applicant(s)

WESTLUND ET AL.

Examiner

Carl H. Layno  
7/18/05

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Preliminary Amendment***

1. Acknowledgment is made of applicant's preliminary amendment which was received by the Office on October 12, 2004.
2. Claims 2-37 are canceled. Only, claim 1 is active.

### ***Priority***

3. Acknowledgment is made of applicant's claim for priority as a Continuation of U.S. Application Serial No. 10/081,436, filed February 20, 2002, now U.S Patent No. 6,671,560, which is a Continuation of U.S. Application Serial No. 09/466,266, filed December 17, 1999, now U.S. Patent No. 6,356,791, which is a Continuation-In-Part (CIP) of U.S Application Serial No. 09/164,891, filed October 1, 1998, now abandoned, which is a Continuation-In-Part (CIP) of U.S Application Serial No. 09/097,101, filed June 12, 1998, now abandoned.

### ***Specification***

4. The disclosure is objected to because of the following informalities:  
  
-p.1 of specification, line 2, U.S Application Serial No. 10/081,436 should be updated to reflect that this is now U.S Patent No. 6,671,560.  
  
Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Otten '439 or Spehr et al '433.

The Otten '439 patent describes a general purpose catheter 2 (Fig.1) equipped with a plurality of electrodes 4, 6, 8, and 10 proximate its distal end, and having a lumen for accepting a guiding stylet 22. The stylet 22 performs the same function as applicant's guidewire and is equipped with a rounded tip end 48 for engaging a socket portion 46 of the catheter 2. The stylet 22 is used during the implantation and anchoring of catheter 2 within the body, after which it may be withdrawn (col.3, lines 10-55). The device may be used for treating cardiac conditions and as part of a cardiac pacing lead (col.1, lines 29-31 and col.2, lines 30-46).

The Spehr et al '433 patent describes an implantable endocardial lead 10 (Fig.1) with an internal coil 22 defining a lumen for accepting a stylet 50 (Figs. 3 and 4) equipped with an engaging coil segment 62. The stylet performs the same function of applicant's "guidewire". In use, the stylet 50 may engage the lead 10 during implantation (col.4, lines 41-45) after which the stylet/guidewire may be withdrawn.

***Double Patenting***

7. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and

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useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claim 1 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6,356,791. This is a double patenting rejection.

### *Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

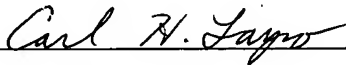
The Goode et al '347 patent describes a flexible stylet wire 200 (Fig.3) having a means for engaging 205 a coiled cardiac lead 211. Though stylet 200 appears to have the same structure as applicant's "guidewire", it is used for extraction of the cardiac lead rather than insertion.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl H. Layno whose telephone number is (571) 272-4949. The examiner can normally be reached on Monday thru Thursday from 9 AM to 6 PM and every other Friday between 9AM and 5PM. A voice mail or E-mail message ([carl.layno@uspto.gov](mailto:carl.layno@uspto.gov)) may be left if desired.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes, can be reached on (571) 272-4955. All faxed communications should be sent to the Office's Official FAX number (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Legal Instruments Examiner (LIE) Brenda Webb whose telephone number is (571) 272-4399.

A handwritten signature in cursive script, reading "Carl N. Layno", is positioned above a horizontal line.

CARL LAYNO  
PRIMARY EXAMINER

CHL  
7/8/2005.